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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,524	02/11/2004	Gosse Jan Adema	DX0670KB1B	8025

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EXAMINER

BUNNER, BRIDGET E

ART UNIT

PAPER NUMBER

1647

DATE MAILED: 04/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/777,524

Applicant(s)

ADEMA ET AL

Examiner

Bridget E. Bunner

Art Unit

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 21-32 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Status of Application, Amendments and/or Claims

The amendment of 12 October 2004 has been entered in full. Claims 1-20 are cancelled and claims 21-32 are added.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 21-29, drawn to a substantially pure or isolated polypeptide comprising an amino acid sequence of SEQ ID NO: 2, classified in class 530, subclass 350.
 - II. Claims 21-29, drawn to a substantially pure or isolated polypeptide comprising an amino acid sequence of SEQ ID NO: 4, classified in class 530, subclass 350.
 - III. Claims 30-32, drawn to a method of modulating physiology of a cell comprising contacting the cell with the polypeptide of SEQ ID NO: 2, classified in class 435, subclass 375.
 - IV. Claims 30-32, drawn to a method of modulating physiology of a cell comprising contacting the cell with the polypeptide of SEQ ID NO: 4, classified in class 435, subclass 375.

The inventions are distinct, each from the other because of the following reasons:

- a. Although there are no provisions under the section for "Relationship of Inventions" in M.P.E.P. § 806.05 for inventive groups that are directed to different products, restriction is deemed to be proper because these products constitute patentably distinct inventions for the following reasons. Groups I-II are directed to products that are distinct both physically and functionally, are not required one for the other, and are therefore patentably distinct. Each of Groups I-II is directed to a unique amino acid sequence, requiring a unique search of the prior art. Searching all of the sequences in a single patent application would provide an undue search burden on the examiner and the USPTO's resources because of the non-coextensive nature of these searches.

- b. Inventions III-IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). Inventions III-IV are different methods because they require different ingredients, process steps, and/or endpoints. For example, Group III requires search and consideration of modulating cell physiology comprising contacting the cell with the polypeptide of SEQ ID NO: 2, which is not required by the other invention. Group IV requires search and consideration of modulating cell physiology comprising contacting the cell with the polypeptide of SEQ ID NO: 4, which is not required by the other invention. Therefore, each method is divergent in materials and steps. For these reasons, the Inventions III-IV are patentably distinct. Furthermore, the distinct steps and products require separate and distinct searches. The inventions of Groups III-IV have a separate status in the art as shown by their separate search requirements. As such, it would be burdensome to search the inventions of Groups III-IV together.
- c. Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product claimed can be used in materially different methods, such as a probe in immunoassays, in therapeutic methods, or in the generation of antibodies. Additionally, searching the inventions of Groups I and III together would impose serious search burden. The inventions of I and III have a separate status in the art as shown by their different classifications. Moreover, in the instant case, the search for the polypeptide and method of modulating cell physiology using the polypeptide are not coextensive.

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- d. Inventions II and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product claimed can be used in materially different methods, such as a probe in immunoassays, in therapeutic methods, or in the generation of antibodies. Additionally, searching the inventions of Groups I and III together would impose serious search burden. The inventions of I and III have a separate status in the art as shown by their different classifications. Moreover, in the instant case, the search for the polypeptide and method of modulating cell physiology using the polypeptide are not coextensive.
- e. Inventions I and IV are unrelated because the product of Group I is not used or otherwise involved in the process of Group IV.
- f. Inventions II and III are unrelated because the product of Group II is not used or otherwise involved in the process of Group III.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bridget E. Bunner whose telephone number is (571) 272-0881. The examiner can normally be reached on 8:30-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on (571) 272-0961. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BEB
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25 March 2005

Bridget E. Bunner